

**REMARKS**

**I. Status of the Claims**

Claims 72, 74-76, and 78-89 are pending in the application. Applicants have amended claims 72 and 74 which is fully supported by the specification as filed. Applicants are simply claiming less than the full scope of their disclosure -- a perfectly legitimate procedure since it is for the inventors to decide what bounds of protection they will seek.

As such, no new matter is being added by the amendments presented herein.

Based on the amendment, Applicants believe that the pending claims are in a condition for allowance.

**III. Rejection Under 35 U.S.C. § 103**

**A. Rejection of Claim 72, 74-76, 78-87, and 89**

Claims 72, 74-76, 78-87, and 89 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over the combination of U.S. Patent No. 6,403,106 (U.S. '106) or WO 97/35541 and WO 97/33556 (WO '556), for the reasons provided at pages 3-9 of the Office Action. The Office notes that WO 97/35541 is the PCT counterpart to U.S. Patent No. 6,403,106 and that they appear to have identical disclosures so they will be referred to as U.S. '106. Office Action at page 4.

Applicants respectfully submit that the claims as amended are patentably distinguishable from the references relied on in the claim rejections, and request

reconsideration and withdrawal of the claim rejections for at least the reasons outlined below.

Amended independent claim 72 now recites a cosmetic composition for making up lips or skin and a dispersion of particles in a liquid fatty phase with an ethylenic insoluble skeleton with soluble side chains. For each separate amendment, Applicants respectfully submit that '106 and '556 fails to meet the *Graham* criteria for obviousness.

Questions regarding obviousness under 35 U.S.C. § 103(a) are resolved on the basis of underlying factual determinations, including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966); see also *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007) ("While the sequence of these questions might be reordered in any particular case, the [Graham] factors continue to define the inquiry that controls."). In making an obviousness rejection, the Examiner must clearly explain the basis for the rejection, including "why the difference(s) between the prior art and the present application would have been obvious to one of ordinary skill in the art." MPEP § 2141(II).

**i. Amended claims are directed towards a composition for making up lips or skin**

Applicants submit that '106 and '556 do not teach or such each and every element of the claimed invention, specifically a cosmetic composition for making up the lips or skin.

The examples in US '106 are directed towards an aerosol or pump action styling spray. US '106 at Examples A-E, col. 11, ll. 1- col. 12, ll. 10. The examples in WO '556 are directed towards a hair styling/conditioning rinse or a shampoo. WO '556 at Examples 3-5, pg. 35, ll. 23; Example 8, pg. 37, ll. 26; Example 9, pg. 38, ll. 26.

In contrast, the examples in the present specification are directed towards lipstick and mascara. Specification at Examples 3-6.

Since the examples are directed towards hair styling compositions in US '106 and WO '556, the compositions are also shown have different transfer capabilities than the present specification. In US '106, the specification states that the styling composition will have "good removal with shampoos." US '106 at col. 12, ll. 26-27. In WO '556, the examples are directed towards "rinse-off" compositions. WO '556 at Examples 3-5, pg. 35, ll. 23; Example 8, pg. 37, ll. 26; Example 9, pg. 38, ll. 26. The ability of the compositions in US '106 and WO '556 to be removed by shampoo or rinsing comes from the composition being in aqueous or hydroalcoholic media. Polymers in these types of media can be easily eliminated by the use of an aqueous solution of surfactants such as a shampoo or soap.

In contrast, the present specification is directed towards a non-transferring makeup composition. The non-transferring property allows the composition to not form a deposit when the lips or skin come in contact with another surface. Specification at pg. 2, ll. 20-25.

WO '556 describes a polymer with hydrophobic side chains. WO '556 at pg. 7, ll. 11. WO '556 teaches that "the hydrophobic side chains of the copolymers are closely associated with each other and thereby exist substantially in one microphase, while the

backbone of the copolymer remains substantially in a separate microphase.” WO ‘556 at pg. 7, ll. 11-14. This means that WO ‘556 describes a polymer that exists in two different phases because of its hydrophobic side chains. In contrast, the present specification teaches a hydrophobic skeleton and hydrophilic side chains that forms a dispersion. Thus, the present specification describes a different polymer than WO ‘556 because it does not cross into separate microphases but forms a stable dispersion.

Therefore, since ‘106 and ‘556 do not teach or suggest each and every element of the claimed invention, this rejection should be withdrawn for at least the reasons above.

**ii. Amended claims are directed towards a dispersion of particles in a liquid fatty phase with polymer having an ethylenic insoluble skeleton with soluble side chains**

Applicants submit that ‘106 and ‘556 do not teach or such each and every element of the claimed invention, specifically a dispersion of particles in a liquid fatty phase.

US ‘106 does not mention a dispersion of particles in a liquid fatty phase. In fact, US ‘106 describes an ethylenic copolymer comprising a hydrophilic skeleton which would be soluble in an aqueous media, rather than forming a dispersion. US ‘106 at abstract. WO ‘556 does not disclose a dispersion of particles in a liquid fatty phase but instead discloses the use of a microphase. WO ‘556 at abstract. WO ‘556 describes the microphases in the specification as “at least two distinct, immiscible, interspersed microphases.” WO ‘556 at pg. 7, ll. 10-11.

In contrast, the present specification describes a stable dispersion which is defined as “a dispersion that is not liable to form a solid deposit or to undergo

liquid/solid phase separation.” Specification at pg. 20, ll. 3-7. By the definition in the present specification, WO ‘556 cannot be defined as a dispersion since it has two distinct immiscible microphases. The present specification also further describes the dispersion as particles that are insoluble in the dispersion medium. Specification at pg. 20, ll. 8-12. Since US ‘106 describes a polymer that is soluble, it cannot be defined as a dispersion as described in the present specification.

In addition, WO ‘556 describes a polymer with hydrophobic side chains. WO ‘556 at pg. 7, ll. 11. WO ‘556 teaches that “the hydrophobic side chains of the copolymers are closely associated with each other and thereby exist substantially in one microphase, while the backbone of the copolymer remains substantially in a separate microphase.” WO ‘556 at pg. 7, ll. 11-14. This means that WO ‘556 describes a polymer that exists in two different phases because of its hydrophobic side chains. In contrast, the present specification teaches a skeleton that is insoluble and soluble side chains in the liquid fatty phase which forms a dispersion. Thus, the present specification describes a different polymer than WO ‘556 because it does not cross into separate microphases but forms a stable dispersion.

Therefore, since ‘106 and ‘556 do not teach or suggest each and every element of the claimed invention, this rejection should be withdrawn for at least the reasons above.

#### **B. Rejection of Claim 88**

Claim 88 was rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over ‘106 in combination with ‘556 and further in view of U.S. Patent 6,254,877 (‘877). Office Action at pg. 8. Applicants respectfully traverse that rejection.

Applicants submit that '877 does not correct the deficiencies of '106 and '556, as discussed above. Accordingly, this rejection is also improper and should be withdrawn.

**IV. Conclusion**

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and timely allowance of the pending claims.

If the Examiner believes that a telephone conversation might advance prosecution of this application, the Examiner is cordially invited to call Applicants' undersigned attorney at (404)653-6466.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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